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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

ST02001USU(159-US-U1)

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Application Number

10/523.669

Filed

August 1, 2005

First Named Inventor

Steve Chang Chiayee

Art Unit

3663

Examiner

To, Tuan C.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

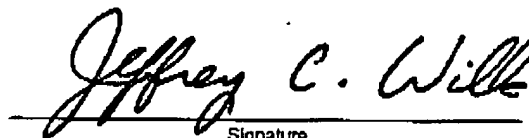
The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 42,227☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



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October 24, 2008

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

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PATENT
Docket No.: ST02001USU (159-US-U1)
Serial No. 10/523,669**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Applicants request review of the final rejection of the above-identified application mailed April 24, 2008. This request is being filed with a Notice of Appeal and a Petition for Extension of Time. No amendments are being filed with this request.

1. Issue Presented for Review

Applicants request review on the basis of a clear legal deficiency in the Examiner's rejection of claims 1-6, 14-17, and 25. In rejecting the above-identified application, the Examiner clearly erred by rejecting claims 1-6, 14-17, and 25 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,542,823 to *Garin et al.* ("*Garin*"). Specifically, in the methods for processing protocol aiding data found in independent claims 1 and 25, the step of converting protocol aiding data received at a call processor of a mobile device to interface data that is transparent to a Geolocation Server Station protocol of a network is not met by the reference cited.

2. Summary of Prosecution

This application was filed August 1, 2005, and in response to an election/restriction requirement mailed March 30, 2007, Applicants elected to prosecute claims 1-6, 14-17, and 25 drawn to a process. A non-final rejection mailed August 7, 2007 rejected these claims under 35 U.S.C. § 102(e). A response was filed traversing the rejection under 35 U.S.C. § 102(e) without amendments. Subsequently, a final Office action was mailed April 24, 2008 and Applicants filed a response amending claims 1, 2, 4, and 17, traversing the same rejection under 35 U.S.C. § 102(e), and requesting an advisory action. The advisory action was issued July 10, 2008 entering the amendments and rejecting the amended claims for the same reasons as set forth in the final

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Office action. Accordingly, Applicants have filed a Notice of Appeal and this Pre-Appeal Brief Request for Review.

3. Applicant's Argument

The claimed subject matter relates to a method for processing protocol aiding data within a mobile device that comprises a step of converting the protocol aiding data to interface data that is transparent to a Geolocation Server Station protocol. Protocol aiding data assists a GPS-enabled mobile device by providing aiding data through a communication module that assists the GPS receiver in determining the location of the mobile device. In the case of a mobile telephone, e.g., a cell phone, the aiding data is provided by Geolocation Server Stations located at the cellular network and may be cellular network and vendor specific. Therefore, the GPS receiver in the mobile telephone typically must be compatible with the Geolocation Server Station of the cellular network. *See specification*, paragraph [00020], page 8.

In the final Office action (at pages 2-3), the Examiner states the basis for the rejection under 35 U.S.C. § 102(c) as follows:

Regarding claims 1 and 25, Garin et al. teaches a method for processing, within a mobile device, protocol aiding data received at a call processor with a Global Positioning System ("GPS") interface, where the protocol aiding data is produced according to a Geolocation Server Station protocol (6542823, column 5, lines 4-21, the handset 104 comprises a call processor CP 200 for performing call processing to receive data from a geo-location server (108)), the method comprising: receiving, at the GPS interface, the protocol aiding data received at the call processor ('823, figure 2, GPS section 202 receives the data from the geolocation server via the base station 106), converting the received protocol aiding data to interface data that is transparent to the Geolocation Server Station protocol; and passing the interface data to a GPS module ('823, figure 2, the serial communication lines 204 is used to convert the received data from geo-location and passes it to the CP section 200).

In his Response to Arguments (page 4), the Examiner states that that "[t]he wireless handset includes all necessary components for receiving protocol aiding data as said above and

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converting the received protocol aiding data to interface data that is transparent to the Geolocation server station protocol.” The Examiner refers to col. 4: lines 29-33 and FIG. 1 of *Garin*, for the proposition that the disclosure in *Garin* includes “wireless communication platforms including: CDMA, TDMA, AMP, and even pager system[s].”

It is not enough, however, that the prior art reference “disclose all elements of the claim within the four corners of the document, but [it] must also disclose those elements ‘arranged as in the claim’.” *Net MoneyIN, Inc., v. VeriSign, Inc.*, No. 2007-1565 (Fed. Cir. October 20, 2008). See also MPEP § 2131. In the case of a method, a prior art reference “operating in a different way” is deficient under 35 U.S.C. § 102 because it does not disclose the elements of the claimed invention “arranged as in the claim.” *Net MoneyIN, Inc.*, at page 16, citing *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452 (Fed. Cir. 1984).

If, based on the reference to various wireless communication platforms in the specification of *Garin*, the Examiner is asserting that the element of converting protocol aiding data is an inherent disclosure of *Garin*, “the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” MPEP § 2112 IV., citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner has not done this, and as further explained below, *Garin* does not teach or suggest the receipt and conversion of protocol aiding data and this feature/element does necessarily flow from the teachings of *Garin*.

In general, *Garin* is related to a multi-mode Global Positioning System (GPS) system for use in a wireless network that operates in multiple modes, such as a standalone mode, an

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autonomous mode, a "network aided" mode, and a "network based" mode, where the GPS system switches between these modes of operation based on several variables. As shown in FIG. 2 of *Garin*, communications are transferred between a call processing (CP) section 200 and a GPS section 202 of handset 104 over a serial communications link 204 and hardware lines 206 (col. 5: lines 24-33). There is, however, no mention made of converting any of the data that may be transferred between the CP section 200 and the GPS section 202 of handset 104 let alone a specific reference to converting protocol aiding data so as to make it transparent to the Geolocation Server Station protocol utilized by the GPS section 202.

As for claim 2, which includes the element of packing transparent interface data into a message format before passing the transparent interface data to a GPS module, the Examiner claims that this too is taught by *Garin*, citing the abstract. Again, all that the abstract describes is a GPS system for use in wireless networks that can operate in multiple modes, such as a standalone mode, an autonomous mode, a "network aided" mode, a "network based" mode, and other modes.

In summary, *Garin* is related to the operation of a GPS system in different modes depending on the network facilities and bandwidth available, and does not teach or disclose anything related to the process of converting protocol aiding data so as to make it compatible with the various protocols of Geolocation Server Stations that may be used. The Examiner claims that the system disclosed in *Garin* includes all necessary components for receiving and converting protocol aiding data to interface data, but *Garin* does not disclose the necessary components arranged for the receipt and conversion of protocol aiding data, nor is this element inherently disclosed by *Garin*.

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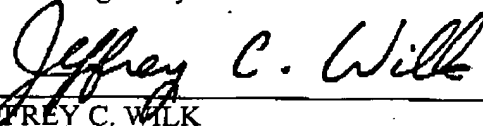
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Based on the foregoing, Applicants respectfully submit that *Garin* does not teach or disclose each and every feature or element recited in the rejected independent claims 1 and 25, *i.e.*, the step of converting received protocol aiding data to interface data that is transparent to the corresponding Geolocation Server Station protocol utilized by the GPS module or section of the wireless device. In conclusion, an element or feature is not met by a reference and therefore this matter is appropriate for panel review. Therefore, Applicants respectfully submit the foregoing request for review.

Respectfully submitted,
Steve Chang Chiayee et al.

Date: October 24, 2008

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